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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLIVIER PINTO

Appeal 2009-005112
Application 10/719,698
Technology Center 1700

Decided: April 19, 2010

Before MICHAEL P. COLAIANNI, BEVERLY A. FRANKLIN, and JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is in response to a Request, filed February 16, 2010, for rehearing of our Decision, decided December 22, 2009, wherein we affirmed all the appealed rejections.

Appellant argues that the Board erred in adopting the Examiner's construction of the claim term "chemically bonded" as including ionic, covalent, or hydrogen bonding of the phosphorus group to the polymer after

polymerization (Request 4). Appellant contends that the Board's analysis with regard to construing "chemically bonded" on page 5 of the Decision is incorrect (Request 5). Appellant contends that the Specification is clear that the phosphorus group is incorporated into the polymer structure through polymerization because it is described as being a precursor throughout the Specification and is exemplified as such (Request 6).

We disagree and adhere to our analysis on page 5 of the Decision. Claim 1 recites two precursors. The claim recites "a precursor for said polymer" as being selected from the list of compounds recited in the claim. The claim further recites "an additional precursor such that said phosphorus group is chemically bonded to said polymer after polymerization." The claims do not require that the "additional precursor" forms the polymer as is the case with the first recited precursor in the claim. Indeed, the "additional precursor" does not rely on the "precursor for said polymer" for antecedent basis in the claim. So, the plain meaning of claim includes an "additional precursor" as part of the polymerizable liquid which bonds the phosphorus group to the polymer after polymerization in some manner.

We do not disagree with Appellant that the claim encompasses embodiments where the phosphorus group is part of the precursor of the polymer such that the phosphorus group is covalently bonded to the polymer chain (e.g., Examples 1 and 2 of the Specification). However, the claim is broader than simply those embodiments and may reasonably be construed as including other forms of chemical bonding. Indeed, our construction is supported by Appellant's disclosure, which states:

> In a preferred embodiment, the phosphorous group may be chemically bonded to said polymer, and in this embodiment, the precursor of said polymer *may* include at least one phosphorous group.

(Spec. 2)(Emphasis added).

This disclosure plainly indicates the precursor *of the polymer* need not necessarily have at least one phosphorous group. In other words, the phosphorus group may be chemically bonded to the polymer in ways other than as being part of the precursor used to form the polymer chain (e.g., ionic or hydrogen bonding of a phosphorous group compound to the polymer).

Appellant contends that the science of a precursor composition is such that covalent bonding of the precursor to form the polymer chain results (Request 6). Appellant further argues that construing "chemically bonded" as including hydrogen bonding or ionic bonding is improper because such a construction would make the claim scientifically inoperable. Appellant cites to an exhibit titled "A Brief Introduction To Polymeric Materials" as showing that polymer chains have covalent bonding. However, because Appellant failed to direct us to where this exhibit was relied upon in the briefs, the citation of the polymeric materials exhibit is new evidence which we shall not consider. 37 C.F.R. § 41.52 (2009).

Regarding Appellant's arguments that precursors are covalently bonded to form the polymer chain and that our claim construction of "chemically bonded" to include ionic or hydrogen bonding would make the claimed subject matter inoperable, these arguments fail to appreciate that the claim does not require that the "additional precursor" be a "precursor for

said polymer." The additional precursor may be a precursor for some other compound that is chemically bonded in some manner (e.g., ionic or hydrogen bonding) to the polymer. The above quoted section of the Specification supports this construction.

For the above stated reasons, we adhere to our determination that we properly construed "chemically bonded" and that the § 102 and § 103 rejections are affirmed for the reasons set forth in the Decision.

The Request for Rehearing is granted to the extent that we have reconsidered our Decision, but is denied as to the request to modify our Decision.

DENIED

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